

S/N 10/763,937

Atty Dkt No. GP-303007 (GM0399PUS)

### Remarks

Claims 1-21 are pending. Claims 1-11 and 21 are withdrawn. Claim 12 is rejected under 35 U.S.C. § 102(b) as being anticipated by Artner et al (6,141,935). Claims 12-15 are rejected under 35 U.S.C. § 102(b) as being anticipated by Pruitt et al (5,890,285). Claims 16-20 are objected to, but contain allowable subject matter. Applicants respectfully request reconsideration of the rejections in view of this reply.

#### Rejection of claim 12 under 35 USC § 102(b) as being anticipated by Artner et al

For a rejection to be proper as an anticipation under 35 U.S.C. § 102, every element and limitation found in the rejected claim must be found in the § 102 reference. "A claim is anticipated **only if each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See MPEP §2131.

Claim 12 recites "providing a unitary panel having a first portion formed as a vehicle body compartment lid outer panel and a second portion formed as a vehicle body compartment lid inner panel; and bending the panel to form a crease between the first portion and the second portion." (emphasis added).

In rejecting claim 12 as being anticipated by Artner et al., the Examiner states "Artner discloses a method of [sic] forming a vehicle panel ... comprising: providing a unitary panel having a first portion formed as an outer portion (1), and a second portion formed as an inner portion (2a-b, 3)." (emphasis added).

Notably, the Examiner does not state that Pruitt et al discloses a "method of manufacturing a vehicle body compartment lid," including a "panel having a first portion formed as a vehicle body compartment lid outer panel and a second portion formed as a vehicle body compartment lid inner panel," as recited by claim 12. Instead, the Examiner more generally states that Pruitt et al. disclose a method of "forming a vehicle panel" having "a first portion formed as an outer portion" and "a second portion formed as an inner portion." The Examiner

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does not address the limitation of claim 12 that the panel forms portions of a "body compartment lid."

Artner et al. merely disclose a "structural member." See Artner et al., column 2, line 53. Nowhere does Artner disclose that the structural member 1 forms any portion of a "body compartment lid," as recited by claim 12. Accordingly, Artner et al. do not describe, either expressly or inherently, "each and every element" of claim 12, as required for a proper rejection under 35 U.S.C. § 102(b). Therefore, the rejection of claim 12 under 35 U.S.C. § 102(b) as being anticipated by Artner et al. is improper.

Rejection of claims 12-15 under 35 U.S.C. § 102(b) as being anticipated by Pruitt et al

In rejecting claim 12 as being anticipated by Pruitt et al, the Examiner states that "Pruitt discloses a method of forming a vehicle body panel ... comprising: providing a unitary panel having a first outer portion ... and a second inner portion." Notably, the Examiner does not state that Pruitt et al disclose a "method of manufacturing a vehicle body compartment lid," including a "panel having a first portion formed as a vehicle body compartment lid outer panel and a second portion formed as a vehicle body compartment lid inner panel," as recited by claim 12. Instead, the Examiner more generally states that Pruitt et al. disclose a method of forming a "vehicle body panel" having a "first outer portion" and "a second inner portion."

Pruitt et al. disclose a method of forming an airfoil. See Pruitt et al., column 5, line 12. Pruitt et al. do not disclose a method of forming a "vehicle body compartment lid." Although the Abstract of Pruitt et al., cited by the Examiner in support of the rejection, may include broad examples of a hollow structure being "a member used in automobiles, furniture, boats, buildings, railroad cars, hospital equipment," Pruitt does not expressly or inherently describe a "vehicle body compartment lid" as recited by claim 12. Accordingly, Pruitt et al. do not teach providing a "panel having a first portion formed as a vehicle body compartment lid outer panel," as recited by claim 12.

For a rejection under 35 U.S.C. § 102(b) to be proper, the cited reference must describe, either expressly or inherently, each and every claim element and limitation.

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Accordingly, the rejection of claim 12 under 35 U.S.C. § 102(b) as being anticipated by Pruitt et al. is improper.

Claims 13-15 ultimately depend from claim 12 and are therefore allowable for at least the same reasons that claim 12 is allowable.

Claims 16-20 ultimately depend from claim 12, and therefore Applicants respectfully submit that the objections to claims 16-20 are overcome.

### CONCLUSION

This Amendment is believed to be fully responsive to the Office Action mailed June 13, 2005. The remarks in support of the rejected claims are believed to place this application in condition for allowance, which action is respectfully requested.

Respectfully submitted,

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